

REMARKS

Claims 10 to 13 and 15 to 20 are now pending.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claim 19 was rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

Applicants respectfully traverse this rejection and submit that the specification discloses claim 19 and its feature of suppressing the at least two different functions is done without resetting any hardware arrangement. (See, e.g., page 3, lines 9 to 13).

In view of the foregoing, Applicants respectfully request withdrawal of the indefiniteness rejection of claim 19.

Claims 19 through 20 were rejected under 35 U.S.C. § 112 as to enablement.

It is respectfully submitted that the specification as filed enables one of skill in the art to suppress function(s) without resetting any hardware arrangement without undue experimentation. Lines 9 through 13 of page 3 of the present application provide an enabling disclosure and description for one of skill in the art to suppress function(s) without resetting any hardware arrangement, as provided for in the context of the claimed subject matter.

Withdrawal of the enablement rejections of claims 19 and 20 is therefore respectfully requested.

Claims 10 to 13 and 15 to 18 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,105,420 to Ardon et al. ("Ardon").

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from

the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

The Ardon reference concerns a method and structural arrangement for reconfiguration of switching system functional units where although the distributed control entities and the distributed switch units of a switching system are in fixed association. The association between peripheral circuits and the control and switch units is not fixed, since a group of peripheral circuits is connectable to at least first and second ones of the distributed switch units. When the group of peripheral circuits is connected to the first distributed switch unit, the control unit associated with the first distributed switch unit processes calls to and from the group of peripheral circuits. When the group of peripheral circuits is connected to the second distributed switch unit in response to a reconfiguration signal, the control unit associated with the second distributed switch unit processes calls to and from the group. In particular embodiments, the selective connection of the group of peripheral circuits to different distributed switch units is effected by an interconnection arrangement used to interconnect the switching system and a multiplex of communication circuits from a transmission facility. In one embodiment, the interconnection arrangement is implemented using a digital access and crossconnect system (DACS), and a second embodiment uses a plurality of add/drop multiplexers interconnected in a fiber ring.

The Ardon reference, considered separately or in any combination, does not disclose or suggest the feature of “selecting the function to be implemented from one of at least two different functions by using a predefinable code for providing an implemented function; and suppressing other ones of the at least two different functions,” in which the predefinable code includes information pertaining to a waiting time corresponding to a period of time, after which a switch is made from the function to be implemented to a further function of the at least two different functions, the “further function being suppressed during the period of time,” as in claims 10 and 15.

The Final Office Action appears to rely on the AM module 4000 as support for a predefinable code to select the function to be implemented from one of at least two different functions, and it further asserts that this AM software module 4000 includes information

pertaining to a waiting time as corresponding to idle time slot. *Paper Number 20080215, pg 6 and 9.*

In particular, Ardon's system is implemented with hardware architecture with components including an administrative module (AM), a communications module (CM), and one or more switching module (SMs). (*Ardon, col. 2, lines 19 to 24.*) The majority of the functions within the AM module are performed using hardware components. This includes reliability functions done using processors, and error checking circuitry for detecting and isolating faults. (*Ardon, col. 2, lines 45 to 65.*) The entire disclosure points to only two instances of software utilization, namely, software recovery and initialization, and software access to external data links and to disk storage. (*Ardon, col. 2, lines 60 to 65.*) Significantly, Ardon does not draw any link between its software codes and the ability to select one function of at least two different functions by using the software codes. That is, Ardon does not use its software within AM 4000 to select the function to be implemented from one of at least two different functions. As such, Ardon does not disclose selecting the function to be implemented from one of at least two different functions by using a predefinable code for providing an implemented function, as provided for in the context of the claimed subject matter.

Furthermore, Ardon does not teach the above predefinable code (in AM 4000) as including information as to a wait time. Specifically, the time slots, which include idle time slots, are not a part of AM 4000, nor a part of any predefinable code. In particular, the time slots are part of the NCT link which carries 256 channels of multiplexed data in a serial bit stream. (*Ardon, col. 6, lines 32 to 34.*) Notably, the time slots are merely an architectural design of the NCT link, rather than a waiting time corresponding to a period of time. This architectural design is completely separate and independent of the AM 4000 or any other hardware components of Ardon's system. Indeed, AM 4000 is silent on even utilizing the time slots in the first place. Specifically, it is the SM and TSIU hardware components, and not the AM module that establishes a path between the selected NCT time slot and the peripheral time slots associated with the line or trunk between two SMs. (*Ardon, col. 6, lines 40 to 46.*) Moreover, within each SM, there is an TSIU 3010, which includes a signal processor. The Ardon system uses this hardware component to handle address and signaling information, the TSIU switches time slots between the interface units in an SM and connects time slots from the interface units to time slots on NCT links. Accordingly, Ardon does not

disclose that the predefinable code includes information pertaining to a waiting time corresponding to a period of time.

Also, the goal of Ardon's system is not to suppress any functions, since it is silent on suppression of any functions. Indeed, Ardon's system attempts to best distribute all network traffic through the time slot structure within the NCT architecture. This is done through the TSIU signal processor, a hardware component that switches time slots between the interface units in an SM and connects time slots from the interface units to time slots on NCT links. (*Ardon*, col. 7, lines 17 to 27; and lines 57 to 62.) Moreover, Ardon's system tries to connect any of its peripheral time slots to any other peripheral time slot, or to any of the network time slots on NCT links 2056. (*Col. 8, lines 23 to 27.*) Significantly, even for heavy network traffic conditions where semi-permanent connectivity between SM-2000 and SM-2000' may become congested connecting through CM 2055, Ardon discusses alternative means of network connectivity through DNU 2059, and CM is used only when the semi-permanent connectivity through DNU is all being used for other calls. (*Ardon*, col. 8, lines 54 to 62.) That is, Ardon continuously tries to fulfill traffic demands through hardware switching in between NCT channels architecture through a period of time, rather than suppressing other functions during the period of time, as provided for in the context of the present application.

Claims 19 and 20 were rejected under 35 U.S.C. 103(a) as unpatentable over the Ardon reference.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

Id., at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Still further, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

Regarding the obviousness rejections as to claims 19 and 20, obviousness rejections without documentary evidence “should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration” MPEP § 2144.03(A). Since Ardon does not teach the feature of suppressing the at least two different functions is done without resetting any hardware arrangement, in accordance with MPEP § 2144.03(C) and 37 CFR § 1.104(d) (2), Applicants respectfully submit that an Examiner’s affidavit should be provided as support for the aforementioned obviousness rejections as to the alleged steps (or items) that were present within the art at the time of the presently claimed subject matter.

As further regards the obviousness rejections, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Final Office Action’s generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Final Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

It is believed and respectfully submitted that the present Final Office Action offers no proper evidence, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not the case here — there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a

technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the reference relied upon. As referred to above, any review of the reference, whether taken alone or combined, makes plain that the reference simply does not describe the features discussed above of the rejected claims.

Accordingly, it is submitted that claims 19 and 20 are allowable.

As such, Applicants respectfully submit that Ardon, taken separately or in any combination, describe or suggest the features of independent claims 10 and 15. Claims 11 through 13 and 16 through 20 depend from claim 10 and 15 above respectively, and are therefore allowable for the same reasons as claims 10 and 15.

With respect to claims 13 and 18, the Office has not shown a bidirectional communication connection between the control unit and another control unit or a computer. The Final Office Action cites Figs. 4a and 4b of the Ardon reference as to this claim feature. However, those figures do not in any way disclose that control unit 2061 provides the function of a bidirectional communication connection with another control unit or a computer.

Accordingly, and for the reasons explained above as to claims 10 and 15 -- from which claims 13 and 18 depend, claims 13 and 18 are allowable. It is therefore respectfully requested that the anticipation rejections of these claims be withdrawn.

With respect to claim 16, the Office has not shown the existence of a predefinable code for suppressing a function path in the Ardon reference, as discussed above as to claims 10 and 15. Therefore, the Ardon reference does not disclose nor suggest the feature of an arrangement additional to and independent from a predefinable code for suppressing a function path, as provided for in the context of the claimed subject matter.

U.S. Patent Application No. 09/856,905
Attorney Docket No. 10191/1855
Reply to Final Office Action of February 21, 2008

Accordingly, claims 10 to 13 and 15 to 20 are allowable.

Conclusion

In view of the foregoing, Applicants respectfully submit that all pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

KENYON & KENYON

Dated: 4/21/2008

By: 

Gerard A. Messina
Reg. No. 35,952

One Broadway
New York, NY 10004
(212) 425-7200

CUSTOMER NO. 26646

Handwritten notes:
168 mc.
33,865
Haran C
DEDIRCA)